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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/997,578
Filing Date: November 29, 2001
Appellant(s): KARGMAN ET AL.

Douglas B. Teaney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/6/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the

decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-32 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

A substantially correct copy of appealed claims 1-32 appears on pages 1-9 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 32 of the brief reads "The method of receiving and placing an order on the internet to a selected store of a chain of stores, according to claim 2, wherein step (i) comprises uploading *the order directly into* the computer system of the selected store via at least one of the : The Internet, and direct modem-to-modem connection via the PTSN", while claim 32 added by an amendment filed 6/24/03 reads "The method of receiving and placing an

order on the internet to a selected store of a chain of stores, according to claim 2, wherein step (i) comprises uploading *from* the computer system of the selected store via at least one of the : The Internet, and direct modem-to-modem connection via the PTSN".

(9) Prior Art of Record

5,991,739	CUPPS et al	11-1999
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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14, 16-24 and 26-30, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cupps, et al (US Patent 5,991,739).

As per claims 1, 3, 7, 16, 18, 22, 26, 30, Cupps, et al discloses:

A method of receiving and placing an order on the Internet.../comprises using at least one of: The Internet..(Col. 2, lines 39-41):

storing at an Internet web site at least a partial list of stores.../storing said at least a partial list of stores.../storing a list of stores...(Col. 2, lines 39-50 and Col. 6, lines 19-30);

storing at said Internet web site a postal-service listing of customers...(Col. 5, lines 29-32);

creating the potentiality of establishing a point-to-point connection between the computer.../means for establishing communication with the computer...(Col. 12, lines 4-10);

receiving a request to order...(Col. 12, lines 23-25);

determining at said web site which store of said at least a partial list of stores services the customer...(Col. 12, lines 26-30);

receiving the order from the customer...(Col. 12, lines 65-66);

downloading the order received.../downloading a customer order...downloading the order directly into the computer system of the selected store...(Col. 13, lines 60-62).

a web-site on the Internet...(Col. 8, line 43-Col. 9, line 7).

As per claim 2, Cupps, et al discloses:

uploading from the computer of the selected store...the menu...(Col. 8, lines 43-55).

As per claims 4, 19, 27, Cupps, et al discloses:

storing said customer listing by street address...(Col. 5, lines 33-35).

As per claims 5, 6, 20, 21, 28, 29, Cupps, et al discloses:

comprises storing the service-map...comprising matching the street address of the customer.../comprises comparing the street address of the customer...with the street addresses of a plurality of chosen stores...(Col. 6, lines 39-56 and Col. 7, lines 22-23).

As per claims 8, 9, 32, Cupps, et al discloses:

comprises attempting to download the order first via one of the :
Internet.../comprises downloading the order directly into the computer system of the
selected store via at least one of the : The Internet.../comprises uploading from the
computer system of the selected store via at least one of the: The Internet...(Col. 12,
lines 6-10, where the email communication and web communication allow
downloading/uploading of data between the online ordering machine and the vendor
[selected store]).

As per claim 10, Cupps, et al discloses:

uploading from the computer of the selected store...the estimated time of
delivery...e-mailing the customer...(Col. 11, lines 20-27).

As per claims 11, 24, Cupps, et al discloses:

e-mailing the customer...a message that the selected store...cannot fill the
order...(Col. 10, lines 44-56).

As per claim 12, Cupps, et al discloses:

uploading from at least one of the stores of said chain of stores the street-
address servicing area...storing the street-address servicing area...(Col. 2, lines 45-48,
Fig. 8).

As per claim 13, Cupps, et al discloses:

wherein said step of uploading from at least one of the stores of said chain of
stores the street-address servicing area serviced by each said at least one store of said
chain of stores....(Col. 6, lines 39-56, Col. 2, lines 45-48).

As per claim 14, Cupps, et al discloses:

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wherein the order...is for at least one pizza...(Fig. 8).

The following is inherent with Cupps, et al's system because when ordering pizza, details such as size and toppings must be known in order to complete the order and satisfy the customer:

said customer selecting at least the size of the pizza and the toppings therefor.

As per claim 17, Cupps, et al discloses:

uploading from the computer of the selected store...the menu...(Col. 8, lines 43-55);

comprising storing a list of stores....(Col. 2, lines 39-50 and Col. 6, lines 19-30);

The following is inherent with Cupps, et al's system because when ordering pizza, details such as size and toppings are part of traditional order information:

comprising downloading the size of the pizza ordered...

As per claim 23, Cupps, et al discloses:

placing an automated computer generated, voice-order...(Col. 2, line 62-Col. 3, line 6).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cupps, et al (US Patent 5,991,739).

As per claims 15, 25 and 31, Cupps, et al fails to teach the following:

Normalizing the address entered by the customer using address-normalization software...

Official notice is taken that it is old and well known in the delivery art to normalize addresses using address-normalization software. It would have been obvious to one of ordinary skill in the art to normalize addresses by using address-normalization software because this type of software is traditionally used in mail/delivery businesses to fulfill delivery compliance standards and to process deliveries faster and more efficiently.

(11) Response to Argument

As per claims 1-14, 16-24, 26-30 and 32, appellant argues that Cupps discloses a system where orders to restaurants are received by placing a telephone call to audibly convey an order to a human order taker via an IVR system, or faxes the order to an

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order taker via a store fax machine and does not disclose downloading an order directly into the computer system of the selected store, thereby bypassing the order taking process of the selected store. However, as acknowledged by the applicant, Cupps discloses that the invention is not constrained to transmitting a customer's order to the vendor through the interactive voice recognition system or fax system, but can be implemented through use of a modem connection, which will enable communication between the online ordering machine and the vendor through, for example web communications (See Col. 12, lines 4-10). This web communication would allow the user to skip the voice recognition/fax process and automatically download or upload information to and from the vendor's computer. Col. 9, lines 8-col. 10, lines 21 discusses the ordering process via web communications. Particularly, it is shown that the customer is provided with a web page that prompts the customer for his location, the type of service desired, and other order information. Once the customer has provided all order information through the web page, the customer selections are transmitted to the online ordering machine, which processes the information. In this case, it is not required that a human being take the order from the customer. Here, the order is directly downloaded to the online ordering machine through the web page. In addition, when a customer submits an order request in Cupps, the order can be downloaded to the vendor's computer via the facsimile method as shown in col. 10, lines 26-31. In this case, the order is downloaded directly to the vendor computer system via order *text file*. Note that since the order text file is a file that is transmittable via computer, the order text file is formatted and transmitted to the vendor via fax without relying solely on

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human interaction. In modern technology, a facsimile system can be stored as an application on a computer's hard drive (For example Right Fax software). Therefore, it is not uncommon for the order to be downloaded directly to the vendor's computer when using faxes.

As per claims 15, 25 and 31, appellant argues that the limitation of normalizing of a delivery address is not disclosed by Cupps et al since Cupps et al does not disclose downloading a customer order directly into the computer system of a selected store, thereby bypassing the order taking process of the selected store. However, as discussed above in the preceding paragraph, Cupps et al discloses downloading a customer order directly into the computer system of a selected store in col. 9, line 8-col. 10, line 21 through web page communications. In addition, Cupps et al also discloses that once a customer's location is provided, this location is converted into the appropriate related geocode. According to the applicant's specification, the term "normalize" refers to checking and comparing the input address against a list of normalized, postal service addresses in order to make sure that the address conforms to standard, USPS-CASS (U.S. Postal Service – Coding Accuracy Support System) addresses. This normalization is also said to include the standardization of city zip codes rationalization and postal-delivery. The geocode is no more than standardizing the geographic location of the requesting clients computer into a universal code used for location purposes, which is the same as standardizing a customer's address into a universal code that can be used to locate the customer, which would be the zip code.

For the reasons stated above, claims 1-32 still remain rejected.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A. R. B.
April 25, 2005

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